

REMARKS

Claims 1-24 are pending in the present application.

Claims 6 and 16 were amended for clarity, to explicitly recite a contact area which was implied by the language (“ocular tissue contact” of top and bottom surfaces) of the claims as filed and as described in the specification. The scope of these claims has not been altered by the amendment.

Claims 22-24 were added. Claims 22-24 are believed to define the same patentable invention claimed in application serial number 09/650,584 filed August 30, 2000 by Harold N. Straub and entitled OPTHALMIC DEVICE AND METHOD OF MANUFACTURE AND USE.

The specification was amended to correct typographical errors. No new matter was added by the amendment to the specification.

Reconsideration of the claims is respectfully requested.

35 U.S.C. § 112, Second Paragraph (Definiteness)

Claims 4-7, 11-12, 15-17 and 21 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention. This rejection is respectfully traversed.

Regarding claims 4-5, 7, 12, 15 and 17, the Office Action states:

With respect to claims 4, 5, 7, 12, 15 and 17, these claims use means plus function format which is improper. Under 112 sixth paragraph, the use of means

plus function is only for equivalents that are interchangeable. The different surfaces as applied to the means for stabilizing the prosthesis are actually different parts or surfaces of the prosthesis which are not interchangeable, therefore making the use of the means plus function improper.

Paper No. 6, page 2. However, 35 U.S.C. § 112, sixth paragraph does not actually state that specific embodiments of a means-plus-function limitation must be directly interchangeable:

An element in a claim for a combination may be expressed as a means or step for performing a specified function without recital of structure, material, or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material or acts described in the specification and equivalents thereof.

35 U.S.C. § 112, sixth paragraph. Regardless, the various surfaces are interchangeable to provide the function recited in the claims. For example, the function of stabilizing the prosthesis within the surgically formed pocket which is recited in claim 4 may be achieved by: (a) the bottom surface of the prosthesis adapted as recited in claim 5; (b) the first or second end adapted as recited in claim 7; or (c) a combination of the bottom surface of the prosthesis adapted as recited in claim 5 and the first and/or second end(s) adapted as recited in claim 7.

With regard to claims 6 and 16, those skilled in the art will recognize that the “ocular tissue contact” of top and bottom surfaces refers to an amount (or area) of surface contact of the respective surfaces with ocular tissue as described in the specification at page 15, line 20 through page 16, line 11. The claims have been amended for clarity and explication in this regard.

With respect to claims 11 and 21, the specification teaches that the bottom surface of ends 105a and 105b may have a portion (either in addition to or in lieu of grooves 135a and 135b) which is convex:

It should be noted that although first and second ends 105a,b have a partially concave portion 125 of top surface 110 and grooves 135a,b provide a partially concave bottom surface 120, alternate embodiments may include at least one end 105 that has a partially convex top surface, or bottom surface 120 that may suitably include at least one portion that is at least partially convex.

Specification, page 16, line 20 through page 17, line 2.

Therefore, the rejection of claims 4-7, 11-12, 15-17 and 21 under 35 U.S.C. § 112, second paragraph has been overcome.

35 U.S.C. § 102 (Anticipation)

Claims 1-7, 9, 11-17, 19 and 21 were rejected under 35 U.S.C. § 102(b) as being anticipated by *Baikoff* (French Patent 2,784,287). This rejection is respectfully traversed.

For a patent to constitute prior art under 35 U.S.C. § 102(b), the patent must have issued (or otherwise be published) more than one year prior to the date of the application. *Baikoff* issued on April 14, 2000. However, the present application, filed June 7, 2000, claims priority under 35 U.S.C. § 119(e)(1) to provisional application 60/138,105 filed June 7, 1999.

The prior provisional application names the same (sole) inventor as the present application and discloses the same invention described and claimed in the present application in the manner provided by the first paragraph of 35 U.S.C. § 112, containing substantially the

same content. The prior provisional application was filed in English, and the fee for filing a provisional application was paid upon filing of the prior provisional application. The present application was filed prior to expiration of twelve months after the filing of the prior provisional application, and contains, within the first sentence, a reference to the provisional application identifying that application as a provisional application and including the provisional application number. Accordingly, all requirements for claiming priority to the prior provisional application under 37 C.F.R. §§ 1.78(a)(3) and (4) have been satisfied, and the present application is entitled to a priority date of June 7, 1999, prior to issuance/publication of *Baikoff*. *Baikoff* is therefore not a prior art reference under 35 U.S.C. § 102(b).

Therefore, the rejection of claims 1-7, 9, 11-17, 19 and 21 under 35 U.S.C. § 102 has been overcome.

AMENDMENTS WITH MARKINGS TO SHOW CHANGES MADE

The paragraph bridging page 19, line 22 through page 20, line 9 was amended herein as follows:

The foregoing prosthesis may be manufactured in accord with the methods set forth in the above-incorporated patent documents or otherwise known, may be from materials set forth in the above-incorporated patent documents or otherwise known, may be surgically implanted as set forth in the above-incorporated patent documents or as otherwise known, such as an injection wherein the prosthesis would be inserted and then possibly filled with fluid, plastic or otherwise (in an embodiment wherein the ends extend beyond the scleral pocket, the body of the prosthesis may be filled and the end(s) actually become wider than the incision, precluding movement), including, for instance, new metals.

Claims 6 and 16 were amended herein as follows:

1 6. (amended) The prosthesis set forth in Claim 5 wherein [said]an ocular tissue contact
2 area of said bottom surface of said body is at least substantially equal to [said]an ocular tissue
3 contact area of said top surface of said body.

1 16. (amended) The prosthesis set forth in Claim 15 wherein [said]an ocular tissue
2 contact area of said bottom surface of said body is at least substantially equal to [said]an ocular
3 tissue contact area of said top surface of said body.

If any issues arise, or if the Examiner has any suggestions for expediting allowance of this Application, the Applicant respectfully invites the Examiner to contact the undersigned at the telephone number indicated below or at *wmunck@novakov.com*.

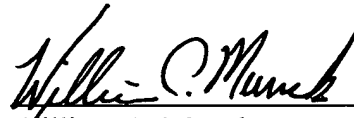
The Commissioner is hereby authorized to charge any additional fees connected with this communication or credit any overpayment to Deposit Account No. 50-0208.

Respectfully submitted,

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Date: _____

April 27, 2001



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